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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,015	06/25/2001	Lionel Breton	016800-450	9059

7590 06/27/2005

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EXAMINER

BERKO, RETFORD O

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,015

Applicant(s)

BRETON ET AL.

Examiner

Retford Berko

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,32,37,52,62-64,69,81,82,85,88-114,117,118,121,122 and 125 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27,32,37,52,62-64,69,81,82,85,88-114,117,118,121,122 and 125 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

3.00

DETAILED ACTION

Acknowledgement: The Amendment filed 4/04/05 is acknowledged.

Status of Claims

1. Claims 1-26, 28-31, 33-36, 38-51, 53-61, 65-68, 70-80, 83-84, 86-87, 115-116, 119-120 and 123-124 have been cancelled in view of the amendment and pursuant to the RCE.
2. The claims currently under examination are: claims 27, 32, 37, 52, 62-64, 69, 81-82, 85, 88-114, 117-118, 121-122 and 125. The claims contain previously presented claims as well as modified claims.
3. In the Amendment filed 4/04/05, applicant cancelled the ff. claims: claims 28-31; 33-36; 35-61; 53-61; 65-68; 70-80; 83-84; 86-87; 115-116; 119-120; and 123-124.
4. Claims 27, 32, 37, 52, 62, 63-64, 69, 81-82, 85, 88-114, 117-118, 121-122 and 125 remain for examination.

Withdrawal of Claim Rejections:

Claim Rejections-35 USC Sec 112

1. The rejections of claims 32, 114-118, 121, 122 and 125 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of applicant's amendment and arguments.

Claim Rejections-35 USC Sec 102

2. The rejection of claim 27 under 35 USC 102(b) as being anticipated by Blank et al (US 5, 837, 697) is withdrawn.

Claim Rejections - 35 USC § 103

I. The rejections of claims 27, 32, 37, 62, 69, 82, 85, 88-114, 117-118, 121-122 and 125 as unpatentable under 35 U.S.C. 103(a) over Blank et al (US 5, 837, 697) in view of the combination of Schaaf et al (US 2, 791, 534), Bobrove et al (US 5, 962, 505) and Galey et al (US 5, 536, 500) is maintained.

Blank et al (Patent '697) teach a cosmetic composition comprising 0.01-50 wt/% cinnamic acid and/or derivatives of cinnamic acid (dihydro cinnamic acid or trihydrocinnamic acid (abstract, col 9, lin 35-40, col 11, lin 31, col 12, lin 67 and col 16, lin 20-25).

Blank does not teach the relationship between cinnamic or its derivatives and the treatment effect the compounds may have on application of a composition containing cinnamic acid or the advantages of using a composition comprising such ingredients.

Schaaf et al (Patent '534) discloses a cosmetic composition comprising cinnamic acid and Peru balsam (col 1, lin 30-45. It is generally known in the art that the components of Balsam of Peru include compounds such as cinnamic acid, cinnamic anhydride, cinnamic alcohol; etc. According to Schaaf, the cosmetic composition comprises pregnelone and its derivatives and that the composition confers advantages for use in that the ingredients stimulate the growth of the epidermis and cell proliferation; thus the inventors point out that the composition is useful for treatment and care of the skin (col 1, lin 1-28).

Bobrove et al (Patent '505) disclose a method of treating hot flashes in menopausal women. According to Bobrove, patients susceptible to hot flashes at menopause are treated with topical composition comprising cinnamic acid (col 4, lin 11-34). Though the composition

Art Unit: 1618

disclosed is a pharmaceutical composition, formulations such as ointment, topical cleansers, creams and skin gels formulations are also available (col 4, lin 50-58).

Galey et al (Patent '500) is relied upon for the disclosure of cosmetic composition comprising cinnamic acid or of one of its derivatives and Vitamin C as ingredients (col 2, lin 10-15). Patent '500 discloses the advantage of the composition—i.e. the ingredients provide anti-oxidant properties and the contribution of the vitamin to synthesis of collagen (col 1, lin 1-25 and col 2, lin 10-15).

One of ordinary skill in the art would have been motivated to make a cosmetic composition comprising cinnamic acid, and mono- or dihydrocinnamic acid as ingredients; as according to the prior art cited. One of ordinary skill would expect reasonable level of success as in the prior art and thereby derive the known advantages and benefits of using such composition (i.e. stimulate growth of skin epidermis; Patent '534 at col 1, lin 25 and enhance collagen synthesis; Patent '500, col 1, lin 10-25). Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill at the time it was made.

2. Claims 27, 37, 52, 63, 64, 69, 82, 85, 88-114, 117-118, 121-122 and 125 are rejected as unpatentable under 35 USC 103(a) in view of Blank et al (US 5, 837, 697) further in view of Bissett et al (US 5, 487, 884) and further in view of Lanzendorfer et al (US 5, 952, 373).

The disclosures of Blank et al (Patent '697) were discussed: the disclosure of cosmetic composition comprising 0.01-50 wt/% cinnamic acid and/or derivatives of cinnamic acid (dihydro cinnamic acid or trihydrocinnamic acid (abstract, col 9, lin 35-40, col 11, lin 31, col 12, lin 67 and col 16, lin 20-25).

Art Unit: 1618

Blank et al does not teach the use of phenylacetic acid as ingredient in the cosmetic composition.

Bissett et al (Patent '884) disclose a photoprotection composition useful for topical application (abstract and col 4, lin 50). According to Bissett, the composition comprises conventional sun screening agents including cinnamic acid derivatives (dihydroxy cinnamic acid and trihydroxycinnamic acid and derivatives; col 17, lin 1-20; vitamin C (col 21, lin 55-60). More importantly, Patent '884 discloses that the composition comprises chelating agents such as 2-hydroxyphenylacetic acid (col 38, lin 50-55), that the chelating agent works in the skin to prevent damaging reactions in the skin and that it also protects the skin from the effects of UV radiation as well as from premature aging (col 11, lin 20-35; lin 50; col 22, lin 15).

Lanendorfer et al (Patent '373) is relied upon for the disclosure that cinnamic acid and cinnamic acid derivatives have been used in cosmetic and dermatologic compositions for treatment or prphylaxis of dermatoses (col 16, lin 57-65, continuing to col17, lin 1-9; col 18, lin 52-60

One of ordinary skill would have been motivated to prepare a cosmetic composition comprising cinnamic acid and include as ingredients vitamin C and chelating agents such as phenylactic acid. One or ordinary skill would expect to obtain a composition that can be effective as topical photoprotection composition in order to prevent the damaging effects of UV rays on the skin caused by chronic exposure. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill at the time it was made.

A. The following prior art reference is cited for the record only as pertinent to applicant's claims but is not relied upon for the rejection of claims in this office action: Kalish et

Art Unit: 1618

al (US 6, 713, 250). The reference is relied upon to show the ingredients in Balsam of Peru because the reference states the components of Peru of Balsam include cinnamic acid, cinnamic anhydride, cinnamic alcohol, vanillin and eugenol. The reference is pertinent because one of the prior art references used in the current rejections above; i.e. Schaaf et al; US 2, 791, 534; discloses that the cosmetic composition comprises cinnamic acid and Peru of Balsam. However, Patent '250 is not currently relied upon because the reference does not disclose cosmetic composition.

B. Derwent 1993-402027: the reference discloses that beta-phenylacrylic acid (i.e. 3-phenylpropenoic acid or cinnamic acid) is useful as an intermediate in the manufacture of cosmetics. The reference is not relied upon the disclosure is only considered ancillary or anecdotal.

C. Breton et al (FR002772612A1): the reference discloses a cosmetic composition comprising cinnamic acid; said composition is for reducing effects of menopause on collagen. The reference is not relied upon as it is non-specific as to the derivatives of cinnamic acid.

Response To Arguments:

Applicant's remarks and arguments have been carefully considered but are found unpersuasive:

Applicant argues that examiner misread Blank et al, that contrary to examiner's position, Blank does not teach a cosmetic composition 0.01-50 wt/% cinnamic acid and/or derivatives thereof such as dihydrocinnamic acid or trihydrocinnamic acid (more accurately, dihydroxycinnamic acid derivatives or trihydroxycinnamic acid derivatives) and further, that cinnamic acid is required in applicant's invention; contending that Blank does not even disclosed cinnamic acid as a sunscreen.

Art Unit: 1618

In response, Blank et al teaches a cosmetic composition comprising a wide variety of sunscreens including cinnamic acid and derivatives and that the sunscreens must be from about 1% to about 20 wt%; preferably 2-10 wt% (col 3, lin 60-65; continuing to col 4, lin 8-20, lin 50-55 and col 16, lin 16-25). The amounts of cinnamic acid and derivatives in Blank read on applicant's claims. Also, cinnamic acid is an active agent in cosmetic/dermatological formulations included at 0.01-20 wt% (see Lanzendorfer, Patent '373 at col 18, lin 39-55).

Applicant argues that the Schaaf reference (Patent '531) was relied upon by examiner to indicate that certain ingredients enhance pregnenolone's action on the skin; however the reference is deficient in that there are no examples of the particular ingredients and that the substances in this category which are in the examples amount to very large percentages as compared to the instant claims where smaller amounts (less than 0.2%); concluding that there would be no reason for one of ordinary skill to select one of the ingredients used in the reference (i.e. Balsam of Peru) and use it in an amount of much less than the large amounts used in the Schaaf reference.

In response, examiner relied upon the reference along with others as the basis for Sec 103(a) obviousness rejection because as applicant has noted, the fact that these ingredients have been used in cosmetic compositions, one of ordinary skill would be motivated to alter the amounts of said ingredients; the motivation would lie on the advantage of the product that would be realized by such modifications of amounts of ingredients. Here, examiner provided the motivation for using the ingredients in various amounts in previous office action. As shown by

Art Unit: 1618

Schaaf, one advantage realized was the advantage in stimulating the circulation in the skin (col 1, lin 45-50).

Applicant argues that there is no reason that is apparent why one of ordinary skill would select a cinnamic salt from the list of possibilities, but even if selected, it would presumably be synthesized from methyl cinnamate, analogous to the last step of the commercial preparation of the bromide contending that even given that possibility, that cinnamic acid itself would not even be present in the topical composition and that would distinguish that composition from the present invention which always has cinnamic acid present. Applicant further argues about the amounts of active cinnamic acid that is present compared to the prior art.

In response, the Sec 103 obviousness rejection was based upon the fact that the prior art of record demonstrates the use of cinnamic acid or cinnamic acid derivatives for making cosmetic and dermatologic formulations having effective treatment or prophylactic advantages. Examiner provided motivations for combining the disclosures in the references to achieve an expected result that would be advantageous. The instant claims are apparently compositions having manipulated amounts of the active agents and those amounts would have been obvious to one of ordinary skill because she could see the advantages of the workable ranges for the end products composition and would therefore engage in routine experimentations to achieve the ranges.

Applicant's remarks regarding lack of reason by examiner for citing the Lanzendorfer reference has been addressed supra. Examiner discovered an inadvertent editorial omission and has corrected the text for the record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Respectfully,

ROB

Correspondence

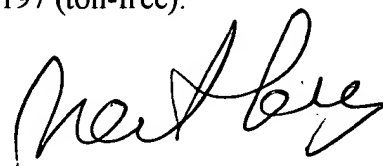
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Retford Berko** whose telephone number is 571-272-0590. The examiner can normally be reached on M-F from 8.00 am to 5.30 pm. Examiner Berko has been assigned future prosecution of the application.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Thurman K Page**, can be reached on 571-272-0602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1618

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Neil S. Levy". The signature is fluid and cursive, with the first name "Neil" and last name "Levy" clearly distinguishable.

NEIL S. LEVY
PRIMARY EXAMINER